



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,273	01/18/2005	Robert P Schnall	28657	7217
7590 07/28/2008				
Martin Moynihan Anthony Castorina Suite 207 2001 Jefferson Davis Highway Arlington, VA 22202				
EXAMINER				
MALLARI, PATRICIA C				
ART UNIT		PAPER NUMBER		
3735				
MAIL DATE		DELIVERY MODE		
07/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/520,273

Applicant(s)

SCHNALL, ROBERT P

Examiner

PATRICIA C. MALLARI

Art Unit

3735

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *The changes to claims 11 and 18 raise new issues that would require further consideration and/or search.* (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Patricia C. Mallari/
Examiner, Art Unit 3735

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's argument that the finality of the previous Office action was premature is not persuasive. Although the text of claim 33 was not changed, claim 33 depends from claim 1. The applicant's amendments to claim 1, therefore, changed the invention of claim 33. Applicant's statement that the objection to claims 24-32 was made for the first time in the previous Office action is moot, since claim objections have no bearing on the propriety of making an action final. MPEP 706.07(a) states that a second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims, nor based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). This section of the MPEP does not address the effect of new objections on the propriety of making an action final. All new grounds of rejection set forth in the previous Office action were necessitated by the applicant's amendments to the claims. Therefore, the finality of the Office action was indeed proper.

As to the applicant's argument that Archibald does not generate its own pressure, independently of an external source, the applicant should note that there is no claim limitation requiring that the probe or pressure applicator generate its own pressure.

As to the applicant's argument that the Moses reference discloses using a pressure cuff which "by definition encircles a body part", the examiner disagrees. Claim 1 merely claims "the probe being configured to be applied to a relatively restricted area . . . which area does not completely encircle the body part at said measurement site". The cuff of Moses is capable or configured to be applied to an area that does not completely encircle the body part at the measurement site. For example, one could merely place the cuff over a body part without securing the cuff around the body part. The applicant further appears to oppose the evaluation of the "results language" identified in the previous Office action, and states that the language is not functional language but structural language. However, the previous Office action demonstrates that Moses teaches all of the claimed structural limitations. Moreover, the applicant has failed to point out any structural differences between the prior art and the claimed invention and has further failed to show that the probe of Moses is unable or wholly incapable of performing the recited functions. Additionally, applicant's decision to treat a statement of "results language" as a concession of differences between the prior art and the claimed invention is erroneous and ill-deserved. No such concession was intended, implied, or stated.

The applicant's evaluation of an obviousness rejection under 35 U.S.C. 103 is further irrelevant. The applicant appears to object to the examiner's usage of the term "capable" in her evaluation. The usage of the term was prompted by the applicant's choice of claim language and not by a misinterpretation or misapplication of 35 U.S.C. 103. The examiner relied upon "capability" in any instance in which the claim language recites "for" performing an action, wherein the term "for" necessarily indicates capability. For example, claim 1 recites "a pressure applicator carried by said base for applying a static pressure to the subject's skin". The claim is not a method claim and fails to state that the applicator applies a static pressure, but instead states that the applicator is "for" applying the pressure, thereby indicating an intended use, wherein the pressure applicator of Bobo is also able to complete such a use. Applicant's description on p. 23 of an oscillometric method as a stepped pressure fails to refute the fact that the pressure is fixed, or "static" during each of the steps, further demonstrating that the pressure applicator of Bobo is able to or "for" applying a static pressure. The applicant further failed to address the fact that the bladder of Bobo is capable of being pressed against the skin manually with a static or constant amount of pressure. The applicant further argues that the bladder and backing of Bobo is so constructed as to generate an indeterminate local force at the tissue interface after the backing is adhered to the skin, wherein the magnitude of such a force could at least partially occlude the arteries. The section of Bobo (col. 3, lines 62-68) cited by the applicant, discloses that the bladder extends from the pad and against the artery only when pressurized in one embodiment. In such an embodiment, the bladder is not described as extending prior to pressurization, and the indeterminate force would not be generated. Therefore, the applicant's arguments are unpersuasive and the prior art rejections stand.